

REMARKS

Favorable reconsideration of the present application is respectfully requested.

Claim 8 has been amended to recite that the groove of the adhesive masking strip has a rounded bottom. Basis for this can be found in Figure 3 and in paragraph [0072]. New claims 22-23 have been introduced. Basis for claim 22 may be found on page 5 of the specification. Basis for claim 23 may be found in Figures 5-6. Claims 8-18 and 22-23 are active in the application, Claims 1-7 and 19-21 having been withdrawn from consideration.

Briefly, the invention is drawn to an adhesive masking strip. In an adhesive masking strip, particularly one used to protect a space between a moving part and a fixed part of the vehicle, the separation between the various fixed parts and moving parts differs appreciably from one vehicle to the next and so it is necessary to produce several sizes of the adhesive masking strip, resulting in significant stocks and multiple handling operations (see paragraphs [0012]-[0013]). According to a feature of the invention, the adhesive masking strip comprises an elongate cellular material which is resistant to a surface treatment and has at least one adhesive region, and which comprises at least one groove, at least a part of a wall of which has a region inclined by an angle of less than 45° with respect to the adhesive region. The groove has a rounded bottom, and so the strip can be easily applied by an operator guiding the strip by inserting at least a part of one finger in the groove. See paragraph [0015].

Claims 8-18 stand rejected under 35 U.S.C. § 103 as being obvious over GB '425. The Examiner there alleges that the reference is "substantially an anticipation of at least applicant's broad claim" except for the claimed angle. However, this rejection is respectfully traversed.

GB '425 is directed to a sponge-like strip 1 used to fill a gap between two edges 4 and 5, in which the strip has an adhesive layer 2 and a V-shaped notch 3 opposite a squared

bottom. Upon the closure of the part having the edge 5, the edge 5 enters the notch 3 and the gap-filling product is sandwiched between the edges 4 and 5, thereby compressing the strip 1 (see first full paragraph of page 4).

Referring to the reference numerals of the figures for illustration and not for limitation, Claim 8 has been amended to recite that the bottom 4 of the groove 2 is *rounded*. This feature was taken from Claim 12, which recites that the bottom has a radius of curvature between 5 and 30 mm when the strip is not compressed. Applicant respectfully submits that, despite the allegation in the Office Action that the claims are anticipated except for the recitation of the specific angles, GB '425 fails to disclose a strip having a rounded bottom.

The Examiner has alleged that the "various geometrical relationships which are claimed by applicant throughout not only independent claim 8 but also the dependent claims are believed to be mere optimization parameters that are well within the ordinary skill of the artisan." The Examiner is thus alleging that certain features of the claims are obvious, despite the fact that they are not taught by GB '425. However, the Examiner is respectfully reminded that the relevant question is not whether any such differences are physically minor, but whether it elements would have been obvious to those skilled in the art at the time of invention to have modified the prior art to produce the invention.

Specifically, a rejection based upon "optimization" of parameters requires that the prior art teaches that the particular parameter to be optimized is a result-effective parameter. *In re Antonie*, 195 U.S.P.Q. 6 (CCPA 1977); M.P.E.P. 2144.05(II)(B). Here, there is nothing in the prior art to suggest that rounding the bottom of the V-shaped groove 3 in GB '425 will "optimize" any parameters of the reference. There is no disclosure in GB '425 that the groove is used for guiding of the strip 1 onto the part 4, and so there is no suggestion that the grooves should have a rounded bottom. The rounded bottom, instead, is taught only by Applicant's disclosure, and so the formation of a rounded bottom for the groove 3 in GB '425 would not have been obvious to those skilled in the art at the time of the invention. Thus the claims recite a feature which is not taught by GB '425, is not consistent with the teachings of GB '425, and would not be the obvious result of "optimization." The amended claims therefore define over this reference.

New Claim 22 recites that the strip is adapted to permit insertion of a substantial part of at least one finger in the groove to guide the strip during application thereof. In contrast, there is no description that the strip 1 of GB '425 is to be applied by the insertion of a substantial part of at least one finger in the groove thereof. Indeed, its rigid square shape and shallow V-shaped groove would make the insertion of a substantial part of at least one finger in the groove virtually impossible. Claim 22 therefore also defines over this reference.

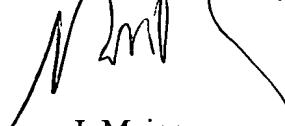
New Claim 23 recites at least two flanges which can be spread or brought closer to each other during use, for example the flanges 10-11. This is incompatible with the rigid strip of GB '425.

The claims have been revised in light of the rejection under 35 U.S.C. § 112, which is believed to be moot.

Applicant therefore believes that the present application is in a condition for allowance and respectfully solicits an early notice of allowability.

Respectfully submitted,

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